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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/769,656	01/25/2001	Wayne McElhaney JR.	629	3470

7590

02/26/2003

Law Offices of John D. Gugliotta P.E., Esq.
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EXAMINER

TRAN, KHOA H

ART UNIT

PAPER NUMBER

3634

DATE MAILED: 02/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	09/769,656	MCELHANEY, WAYNE	
	Examiner	Art Unit	
	Khoa Tran	3634	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 7-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 7-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

Drawings

The drawings are objected to because reference numeral "30" in Figure 3b should be --40--. Correction is required. A proposed drawing correction or corrected drawings are required in reply to the Office action.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 2, 7, and 10 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. The recitations of a U-shaped ring integral to an external portion of at least one of said sidewalls, see claim 1, line 10, and claim 7, line 3; "said cup support means comprising a circular opening", see claim 1, lines 14-15; and "rectangular shaped" storage drawer, see claim 2, line 2, and claim 10, line 2, are considered to constitute new matter. It should be noted that the new recitations set forth in the claims are not found in the original disclosure. In particular, it is first noted that while an element "30" is shown in Figure 2 as integral to the sidewall, this element has been disclosed as a "support means". There is no disclosure of this element being a "ring" nor does the illustration of such evidence a "ring". Second, there is no support in the disclosure for a circular opening that supports

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a cup. Note Figure 2, reference numeral "34" appears to indicate the support plate as "the supporting means for supporting cups". The original disclosure is no more specific in merely reciting "cup support means 34". Third, there is no support in the original disclosure for the drawer being "rectangular shaped". Note that Figure 3b, only shows a side view of the drawer and thus provides no support for "rectangular". Applicant is required to cancel the new matter in the reply to this Office Action.

Claims 1-4, and 7-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1, line 12, it appears that "by" should be --in-- for accuracy. With respect to claim 1, lines 14-15, the recitation of "a cup support means" is no more than a catalog of elements that fails to properly include the necessary structural cooperative relationship to the other recited elements. Further, the reciting of the rag support means as comprising a circular opening is misdescriptive and/or inaccurate because such "means" is constituted by the annular element 36, not the opening defined thereby. With respect to claim 3, there is no antecedent basis for "said rack arm", line 7. Note that multiple arms were set forth.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 4, and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tedrow in view of Klimas. Tedrow discloses a toolbox organizer comprising a storage volume with a lockable lid (14), a lateral support plate (26) for supporting tools, rag, cups or beverage having various sizes of apertures on the plate and extending horizontally from the storage volume. See Figures 2 and 4. The handle, as shown in Figures 1 and 2, constitutes the "U-shaped ring" defining the pneumatic driving tool support means. Klimas teaches a toolbox having a pair of laterally adjustable hooks (11). See Figure 5. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to provide the toolbox of Tedrow with adjustable hooks as taught by Klimas in order to enable the toolbox to hang from a horizontal member of a scaffold or the like.

Claims 2 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tedrow in view of Klimas as applied to claims 1, 3, 4, and 7-9 above, and further in view of Richards. Richards teaches a slidably storage drawer (36 and 42) provides along a lower surface of the toolbox. See Figures 1 and 2. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the toolbox of Tedrow with the provision of a slidably retained drawer as taught by Richards in order to have an extra storage compartment for storage.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hamblin is cited to show devices having similar configurations of design.

Response to Arguments

Applicant's arguments with respect to claims 1-4 and 7-10 have been considered but are moot in view of the new grounds of rejection.

However, it should be noted that it is well-settled that statements of intended use do not serve to distinguish the structural apparatus claimed from the prior art, especially since the manner in which the apparatus is to be used is not germane to the issue of patentability of the apparatus, itself. For example, see *In re Sinex*, 135 USPQ 302 (CCPA 1962) and *In re Casey*, 152 USPQ 235 (CCPA 1967).

Accordingly, in response to applicant's remarks on pages 8-9, what specific organizer structure of the claim(s) is not met by the advanced combination? If applicant desires the lift rack and elements thereof to be a limiting factor of the claimed organizer, then the claims should be amended to clearly and positively recite the combination. Until then, the claims will continue to be interpreted as drawn solely to the organizer subcombination with but one possible field of intended use being recited for such organizer.

Furthermore, it is noted that applicant has failed to point out why the applied prior art is not capable of being "adapted for use with a vehicle lift rack having arms".

Finally, it is noted that applicant has failed to address the Tedrow in view of Klimas rejection previously of record.

The new grounds of rejection were necessitated by applicant's amendment, e.g., "a U-shaped ring", see claim 1, line 10 and "a lateral support plate" see claim 3, line 9.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khoa Tran whose telephone number is (703) 306-3437. The examiner can normally be reached on Monday through Thursday from 9:30 A.M. to 7:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola, can be reached on (703) 308-2686. The fax phone number for this Group is (703) 305-3597 or (703) 305-3598.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-2168.

If the applicant is submitted by facsimile transmission, applicant is hereby reminded that the original should be retained as evidence of authenticity (37 CFR 1.4 and M.P.E.P. 502.02). In general, most responses and/or amendments not requiring a fee, as well as those requiring a fee but charging such fee to a deposit account, can be submitted by facsimile transmission. Responses requiring a fee which applicant is paying by check **should not be** submitting by facsimile transmission separately from the check. Responses submitted by facsimile transmission should include a Certificate of Transmission (M.P.E.P 512). The following is an example of the format the certification might take:

I hereby certify that this correspondence is being facsimile transmitted to the
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Type or printed name of person signing this certificate:

(Signature)

Furthermore, please do not separately mail the original or another copy unless required by the Patent and Trademark Office. Submission of the original response or a follow-up copy of the response after your response has been transmitted by facsimile

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will only cause further unnecessary delays in the processing of your application;
duplicate responses where fees are charged to a deposit account may result in those
fees being charged twice.

Khoa Tran

February 24, 2003

A handwritten signature in black ink that reads "Daniel P. Stodola". The signature is fluid and cursive, with the first name "Daniel" and last name "Stodola" clearly legible, and a middle initial "P" in between.

DANIEL P. STODOLA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600